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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,226	02/13/2001	Akifumi Kamijima	033211-004	7986

21839 7590 12/19/2002

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EXAMINER

PEREZ RAMOS, VANESSA

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 12/19/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,226

Applicant(s)

KAMIJIMA, AKIFUMI

Examiner

Vanessa Perez-Ramos

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-7 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. 5,641,715) in view of Soga et al (U.S. 5,028,938).

In regard to claims 1-2 and 8-9, Okamoto discloses a method comprising: forming a thin film to be patterned (col. 8, lines 48-53 and col. 15, lines 47-60); forming a conductive polymer film, which reads on Applicant's "strippable conductive film", over the thin film (col. 15, lines 61-63); forming a mask on the conductive film by patterning a resist film by using an electron beam writing method (col. 16, lines 5-30); and, removing the "strippable conductive layer" (col. 16, lines 17-19). Furthermore, Okamoto discloses that the conductive film is a grounded film (col. 3, lines 15-20).

Okamoto does not disclose patterning the thin film by dry etching.

Soga discloses a method wherein a film is patterned by wet or dry etching or lithography, such as laser beam, electron beam and the like (col. 3, lines 62-68).

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Okamoto by patterning a film by dry etching, as per Soga, because the use of dry etching for patterning is well known in the art, as evidenced by Soga's disclosure.

Art Unit: 1765

In regard to claims 3-7 and 10-21, these claims differ from claims 1-2 and 8-9 above by adding the limitation that the layer overlying the substrate comprises both a conductive and an insulating layer.

Okamoto discloses that his method is useful either when the first film deposited over the substrate is an insulating film (col. 15, line 40) or a conductive film (col. 15, line 48).

Okamoto is silent about the first film comprising both an insulating and a conductive layer.

It is the Examiner's position, however, that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Okamoto by utilizing both a conductive and an insulating layer as a first film, because Okamoto has shown that his method is equally effective on both layers. and one skilled in the art would be motivated to try a combination of the layers with the anticipation of an expected result.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa Perez-Ramos whose telephone number is 703-306-5510. The examiner can normally be reached on Mon-Thurs 7:00am-5:30pm.

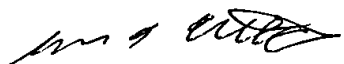
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech can be reached on 703-308-3836. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1765

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

Vanessa Perez-Ramos  
Examiner  
Art Unit 1765

VPR  
December 16, 2002

  
BENJAMIN L. UTECH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700